rebut the rejections contained in the final Office Action, because those rejections rely on newly cited art that was not properly identified in, or transmitted with, the final Office Action.

The February 13, 2004 final Office Action has attached to it two diagrams, one of which appears to be a plasmid map labeled "PASN286-56" and one of which appears to be a plasmid map labeled "pASN286-56GB". The only dates on these two attachments are dates in 2004 and appear to be facsimile transmission dates. The final Office Action contains no data on the origin, date of publication or prior art status of either of these diagrams. Accordingly, Applicants cannot determine whether these diagrams are, in fact, prior art. Furthermore, the copies of the diagrams presented with the final Office Action are poor and contain illegible text and symbols. Despite these failings, the final Office Action clearly relies on these diagrams to support its arguments. See, for example, the paragraph bridging pages 5 and 6 of the final Office Action, which reads, in part:

> "Therefore the enhancer and promoter are less than 1 kb apart. This is conveyed in the plasmid map which is attached to this office action and confirms that the hybrid promoter is as described, with no intervening sequences between the enhancer and promoter. Therefore the plasmid of Antelman et al. meets the limitations of the instant invention."

It is impossible for Applicants to reply meaningfully to the arguments contained in the final Office Action because they are unable to evaluate the origin, publication date, or prior art status of the plasmid maps attached to the final Office Action. Applicants aren't even able to read certain parts of the plasmid maps. Most importantly, Applicants have been offered no opportunity to evaluate the final Office Action's essential implication, that these plasmid maps somehow display what one of skill in the art would have been able to determine about the plasmids disclosed in the Antelman et al reference at the time the instant application was filed. Accordingly, Applicants respectfully request that the finality of the February 13, 2004 Office Action be withdrawn and a new Office Action issued containing full information that will allow applicants to properly evaluate the art relied on in rejecting the instant claims.

Claims 1, 4, 7-16 and 19-20 stand rejected under 35 U.S.C. 102(e) as being anticipated by US 6,074,850 to Antelman et al (hereinafter "Antelman"). Reconsideration and withdrawal of this rejection are respectfully requested. At column 15, line 26-31, Antelman states,

> "This plasmid [pASN286-56] consisted of the adenovirus type 5 inverted terminal repeat (ITR), packaging signals and E1a enhancer, followed by the human smooth muscle α-actin promoter and 286-56 cassette, and then Ad 2 sequence 4021-10462(which contains the E1b/protein IX poly A signal) in a pBR322 background."

Based on this passage in Antelman, the Office Action of July 29, 2003 states,

> "Absent evidence to the contrary, this plasmid [pASN286-56] contains a hybrid promoter that comprising [sic] an enhancer and the human smooth muscle α-actin promoter with no intervening sequences and therefore are less than 1 kb apart. Therefore, the plasmid of Antelman et al. meets the limitations of the instant invention." See page 7, last paragraph.

Essentially, the rejection rests on the argument that the plasmid of Antelman *inherently* meets the instant claims limitation that the enhancer and promoter be less than 1 kb apart.

However, the disclosure of Antelman fails to support this theory of inherency. Apart from the fact that the human smooth muscle α-actin promoter "follows" the E1a enhancer, there is absolutely no information in Antelman about the relative positions of the enhancer and promoter in the plasmid pASN286-56. Antelman contains insufficient information on the synthesis of plasmid pASN286-56 to enable one of skill in the art to determine the sequence of the plasmid in general or the sequence or size of the space between the enhancer and the promoter. Although the rejection baldly asserts that the distance between the enhancer and the promoter must have been less than 1 kb, no such fact can be determined from the disclosure of Antelman.

Distances greater than 1 kb are consistent with the disclosure of Antelman. Antelman simply states that the promoter "follows" the enhancer. Since one of skill in this art knows that the spacial relationship between enhancers and promoters can vary widely, with enhancers being of greatly varied distances both upstream and downstream of promoters, one of skill in the art would not conclude from the Antelman disclosure that the enhancer and promoter of pASN286-56 are *inherently* within 1 kb of each other. Accordingly, this rejection should be withdrawn.

Applicants note that claims 21-23 further limit the distance between the enhancer and promoter and that these claims likewise should not be rejected as anticipated over Antelman.

Claims 1-16 and 19-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Antelman in view of Boshart, et al. Cell (1985) 41:521-530 (hereinafter "Boshart"). Reconsideration and withdrawal of this rejection are respectfully requested. This rejection cites Boshart strictly for the disclosure of an alternate enhancer to the E1a enhancer taught by Antelman. Accordingly, the combination of Boshart and Antelman fails to anticipate or make obvious the instant invention,

because the combination provides no teaching or suggestion of the instant limitation that the enhancer and promoter mush be within 1 kb of each other.

Respectfully submitted,

F. Aaron Dubberley, Reg. No. 41,001
Attorney/Agent for Applicant

Aventis Pharmaceuticals Inc.
Patent Department
Route #202-206 / P.O. Box 6800
Bridgewater, NJ 08807-0800
Telephone (908) 231-3737
Telefax (908) 231-2626

Aventis Docket No. USST98032 US PCT